

REMARKS

The Office Action mailed on June 22, 2009 has been reviewed and the comments of the Examiner carefully considered. Claims 1-5, 7-13, 20 and 21 are pending and currently stand rejected. Claim 1 has been amended herein. Support for these amendments may be found in the originally filed claims and the specification. No new matter has been added by way of these amendments.

Rejections under 35 U.S.C. § 112, First Paragraph (“Written Description”)

Claim 1 was rejected under 35 U.S.C. § 112, First Paragraph, as allegedly lacking sufficient written description for the claimed invention. Claim 1 is rejected for language setting forth that the claimed dyestuff “comprises” a silver salt photostabilizer.

While not necessarily in agreement with the basis for the rejection, but for the sake of advancing prosecution, Applicants have amended claim 1 herein to recite that the dyestuff is a silver salt stabilizer. This amendment is supported throughout the as-filed specification. Furthermore, Applicants note that this amendment in no way limits the manner in which the dyestuff should be understood to function as a silver salt photostabilizer.

Accordingly, Applicants respectfully submit that the written description rejection has been overcome, and request reconsideration and withdrawal of the rejection.

Objection to the Specification

The specification was objected to as failing to provide proper antecedent basis for the claimed subject matter. The objection is apparently based on the language in claim 1 setting forth that the claimed dyestuff “comprises” a silver salt photostabilizer. Applicants have amended claim 1, as set forth above. Accordingly, Applicants respectfully submit that the objection has been overcome, and request reconsideration and withdrawal of the objection.

Rejections under 35 U.S.C. § 112, Second Paragraph (“Indefiniteness”)

Claim 20 was rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More specifically, the Office Action alleges that the phrase “sufficient amount” is vague and indefinite. Applicants respectfully disagree with the rejection and submit that claim 20 is not indefinite for the reasons set forth below.

The entire specification describes the function and effect of the use of the dyestuffs as silver salt photostabilizers (e.g., stabilizes the silver salts against photochemical decomposition by absorbing light near the surface of the material), and additionally, sets forth useful ranges of dye concentrations. *See*, e.g., the specification from page 11, line 7, through page 12, line 15. For example, the specification sets forth that in an embodiment, a suitable dyestuff includes any dyestuff that stabilizes silver salts against photochemical reduction to metallic silver. Therefore, it would be clear that according to claim 20, a “sufficient amount” of such a dyestuff is an amount of the dyestuff necessary to stabilize a silver salt against photochemical reduction to metallic silver. The specification also provides a description of how one of skill in the art can ascertain the stabilization of a silver salt against photochemical oxidation. This description is provided throughout the specification, and for example, in the Experimental Examples.

Therefore, the specification provides a standard for ascertaining the requisite degree of the term (e.g., a sufficient amount of the dyestuff is an amount of the dyestuff that will prevent photochemical decomposition of silver salts, which can be readily determined), and one of ordinary skill in the art is therefore reasonably apprised of the scope of the claimed invention. As described in MPEP § 2173.05(b), when a claim limitation is set forth in sufficient detail that the skilled artisan can readily identify the end result (i.e., an amount of a dyestuff required to prevent oxidation of a silver salt can be determined by assaying the silver salt as described in the specification), the term is not indefinite. Furthermore, as the term “sufficient” is used throughout the specification, it is clear to the reader that the term refers to an amount or degree of something required to bring about a desired effect or result. This is consistent with the claim usage.

Accordingly, Applicants respectfully request withdrawal of the rejection of claim 20 under 35 U.S.C. § 112, second paragraph, and submit that the claim is not indefinite.

Rejections under 35 U.S.C. § 102(e)

Claims 1-5, 7, 11, 13, 20 and 21 were rejected under 35 U.S.C. § 102(e) as being anticipated by Canada et al. (U.S. Patent No. 7,118,761). Applicants respectfully traverse the rejection and submit that the claims are not anticipated for the following reasons.

It is well-settled that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See *In re Bond*, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) and also MPEP § 2131 (quoting *Verdegaal Bros. v. Union Oil C. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). “The identical invention must be shown in as complete detail as is contained in the ...claim” *Id.* (quoting *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Therefore, Canada must describe each and every element of claims 1-5, 7, 11, 13, 20 and 21 in order to anticipate these claims under section 102(e). However, Canada does not meet this burden, because Canada does not teach or describe all of the claim limitations.

The Office Action alleges that Canada teaches a silver salt “which is a complex of Ag⁺ and an anionic polymer” at lines 21-42 of column 8. However, to the contrary, no anionic polymer is taught by Canada, neither in the cited passage, nor anywhere else in the patent. Canada teaches only ion-exchange resins, zeolites, and substituted glass compounds. Canada does not disclose an anionic polymer. Canada goes on to exemplify sodium hydrogen zirconium phosphate, as well as calcium phosphate, as examples of silver ion containing compounds of the patent.

Further highlighting the fact that Canada does not disclose a complex of Ag⁺ and an anionic polymer, it is notable that Canada does not refer to polymers in any manner in connection with the passage cited in the Office Action, despite the fact that Canada refers to polymers elsewhere in the body of the patent.

Additionally, Canada does not disclose or suggest a dyestuff that is a silver salt photostabilizer.

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Therefore, as Canada et al. does not teach, suggest, or otherwise disclose a complex of Ag⁺ and an anionic polymer, nor a dyestuff that is a silver salt photostabilizer, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e). Applicants respectfully submit that claim 1, as amended, and claims 20 and 21 are in condition for allowance, and further that claims 2-5, 7, 11, and 13 are thereby allowable as written as depending from an allowable independent claim.

Rejections under 35 U.S.C. § 103

1. Claims 8-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Canada et al., in view of Camden et al. (US 6,136,835).

The test which must be met for a reference or a combination of references to establish obviousness has not been satisfied in the instant matter. The MPEP states, in relevant part, the proper test for obviousness:

Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. § 103 ...

[T]he four factual inquiries enunciated therein as a background for determining obviousness are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations. (MPEP § 2141).

When applying 35 U.S.C. § 103, the following tenets of patent law must be followed: 1) the claimed invention must be considered as a whole; 2) the references must be considered as a whole; 3) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and 4) reasonable expectation of success is the standard with which obviousness is determined. MPEP § 2141 II. The cited references do not satisfy this required burden to establish a finding of obviousness.

Applicants respectfully submit that claims 8-10 are allowable as depending from an allowable independent claim for the reasons stated above. Canada does not teach, suggest, or otherwise disclose a complex of Ag⁺ and an anionic polymer, nor a dyestuff that is a silver salt

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photostabilizer. Camden does not cure the deficiency of Canada, as Camden does not teach, suggest, or otherwise disclose a complex of Ag⁺ and an anionic polymer, nor a dyestuff that is a silver salt photostabilizer. Accordingly, this combination of references does not provide any guidance or motivation for the skilled artisan to arrive at the claimed invention, and as a result, the skilled artisan would have no reasonable expectation of success in arriving at the claimed invention.

Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e). Applicants respectfully submit that claims 8-10 are in condition for allowance.

2. Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Canada et al., in view of Hirsch (US 1,962,900).

Applicants respectfully submit that 12 is allowable as depending from an allowable independent claim for the reasons stated above. However, for the sake of completeness, applicants submit that the rejection of 12 under 35 U.S.C. § 103(a) as being unpatentable over Canada et al. in view of Hirsch is improper for the following reasons.

Hirsch does not cure the deficiency of Canada, as Hirsch does not teach, suggest, or otherwise disclose a complex of Ag⁺ and an anionic polymer, nor a dyestuff that is a silver salt photostabilizer. Accordingly, this combination of references does not provide any guidance or motivation for the skilled artisan to arrive at the claimed invention, and as a result, the skilled artisan would have no reasonable expectation of success in arriving at the claimed invention.

Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e). Applicants respectfully submit that claim 12 is in condition for allowance.

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Summary

Applicants respectfully submit that the claims are in condition for allowance. An early Notice of Allowance is therefore earnestly solicited. Applicants invite the Examiner to contact the undersigned at (215) 963-5809 to clarify any unresolved issues raised by this response.

The Director is hereby authorized to charge/credit Deposit Account No. **50-0310** (Billing No. 101713-5041) for any other required fees, deficiencies or overpayments in connection with this Response.

Respectfully submitted,

DEBORAH ADDISON ET AL.

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